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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 603,665	06 23 2000	Caroline Barry	GENSET.063AUS	8150

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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
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1656

DATE MAILED: 11 26 2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/603,665

Applicant(s)

BARRY ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 46, 47 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) 76 and 78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46, 47, 65-75 and 77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. The Information Disclosure Statement (Paper No. 5) filed on April 12, 2001 has been entered.
2. Applicant's election of Group IV in Paper No. 8 filed on August 22, 2001 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 46 and 47 are amended (Paper No.8). New claims 65-78 are added. Newly submitted claims 76 and 78 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicants elected Group IV, claims drawn to an isolated polypeptide and antibody. Newly added claims 76 and 78 are drawn to method of binding the antibody, which is classified in separate class 435 and subclass 7.2 and properly be placed in a separate group.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 76 and 78 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Claims 46, 47, 65-75 and 77 are considered for examination in this office action with respect to SEQ ID No. 5.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 47 and 71 are indefinite over the recitation of "capable of selectively binding / capable of expressing" because capability is a latent characteristic and the claims do not set forth the criteria by which to determine capability. That is, it is not clear whether the recited antibody/ polypeptide has the potential to specifically bind or express or do in fact do selectively bind to the recited target. Amendment of the claim to read, for example, "which selectively binds or which expresses" would obviate this rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 46-47, 65-75 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowcock et al. (WO 9812327A2).

Bowcock et al. teach a composition of a purified or recombinant polypeptide which comprises at least 6 contiguous amino acids with (i) at least 1 amino acid position is substituted (see page 6, lines 19-22, page 286-288, SEQ ID No. 52, and sequence alignment, Geneseq database); the polypeptide with at least 20, 50, or so amino acids in length and 10 contiguous amino acids with amino acid substitutions (see page 9, lines 14-15, page 286-288, SEQ ID NO. 52 and sequence alignment, Geneseq database). Bowcock et al. also disclose antibody, which specifically binds to an epitope of binding proteins of human BAP28 sequence (see page 94, lines 28-32). Further Bowcock et al. disclose recombinant vector comprising the BRCA1- associated polypeptides, host cells and a method for producing the proteins or peptides (see page 23, lines

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4-30) and pharmaceutically acceptable carriers (see page 129, lines 6-22). Thus the disclosure of

<sup>powell</sup>  
Baer et al. meets the limitations in the instant claims.

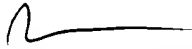
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

<sup>SFC</sup>  
Suryaprabha Chunduru  
November 16, 2001

  
JEFFREY FREDMAN  
PRIMARY EXAMINER